

REMARKS

Claims 8-18 and 21-26 are pending. No new matter has been added by way of the above amendments. For example, claim 8 has been amended to recite the term "isolated" as supported by the present specification at page 6, lines 7-13 as well as page 22, lines 15-19. Accordingly, no new matter has been added. Additionally, no new issues have been raised by way of the present amendment which would require additional search under consideration on the part of the Examiner. In the event that the present submission does not place the application in condition for allowance, entry thereof is respectfully requested as placing the application into better condition for appeal.

Applicants have attached hereto a marked up version of the claims to show the changes made for the Examiner's convenience.

In view of the following remarks Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues Under 35 U.S.C. §112, second paragraph

The Examiner has rejected claims 23-26 under 35 U.S.C. §112, second paragraph for the reasons recited at page 2 of the outstanding Office Action. Applicants respectfully traverse.

First, the Examiner asserts that the phrase "composition comprising isolated theanine" is confusing. Applicants respectfully disagree with the Examiner. The purpose behind the term "isolated" with respect to theanine is to exclude naturally occurring theanine in a composition such as tea. The term "isolated" is known in the art and thus definite.

Second, the Examiner asserts that the term "crudely" in claim 24 is indefinite. Applicants respectfully traverse and submit that "crude" isolation of plant extracts is well known in the art. Accordingly, one of ordinary skill in the art would have no problem in ascertaining the scope of such a term. Accordingly, this rejection is improper and should be withdrawn.

Issues Under 35 U.S.C. §102(b)

The Examiner has rejected claims 8, 11, 16, 23 and 24 under 35 U.S.C. §102(b) as being anticipated by "Applicants own admission". Applicants respectfully traverse this rejection.

The Examiner continues to assert that the present claims read upon general tea consumption. Applicants continue to disagree with the Examiner along this line of argument. That is, the present claims do not encompass naturally occurring tea. Moreover, independent claim 8 has been amended to recite "isolated theanine". Accordingly, this rejection fails.

Moreover, concerning claims 23 and 24 the Examiner asserts that tea is a "theanine extract". Applicants respectfully disagree with the Examiner. For instance, the products according to the present claims are obtained after various steps, such as fractionation, so as to be rich in theanine, and thus do not simply read upon immersing tea leaves in hot water. Accordingly, present claims 8, 11, 16, 23 and 24 are not anticipated by "Applicants own admission". Accordingly, the Examiner is respectfully requested to withdraw this rejection.

Issues Under 35 U.S.C. §103(a)

The Examiner has rejected claims 8, 11, 16-18 and 21-26 under 35 U.S.C. §103(a) as being obvious over "Applicants admission" in view of Wu and Yokoyama. Moreover, the Examiner has rejected claims 8, 11, 16-18 and 21-26 under 35 U.S.C. §103(a) as being obvious over Fujii in view of Brown, Dinning and Woods.

Applicants respectfully traverse each of the Examiner's rejections.

Regarding the rejection of "Applicants admission" in view of Wu and Yokoyama, Applicants respectfully submit that the cited references neither suggest nor disclose the presently (Wu and Yokoyama) claimed subject matter. First, the secondary references cited by the Examiner simply disclose the addition of certain minerals to tea leaves during the growth of the tea leaves in order to increase the production of theanine. This is completely unrelated to the addition of minerals to a composition containing isolated theanine. The Examiner nonetheless asserts that the tea composition is reasonably expected to comprise some mineral components. Applicants respectfully submit that the Examiner's reasoning is flawed. The fact that certain minerals are added to tea leaves during the growth of the tea leaves does not necessarily lead to the conclusion that some of these mineral components will end up in the tea composition.

Moreover, Applicants are not claiming a tea composition. Rather, Applicants are claiming a composition which contains isolated theanine and optionally mineral components. The Examiner's alleged *prima facie* case of obviousness in this regard is tenuous and improper. Reconsideration is requested.

Second, Applicants point out to the Examiner that the cited references completely fail to suggest or disclose the administration of the presently claimed composition to treat symptoms of PMS. The Examiner's reliance on the fact that compositions containing theanine were known in the art is insufficient to render obvious claims directed to methods of treating an individual in need of suppressing or ameliorating symptoms accompanying PMS, comprising administering a composition comprising isolated theanine. The Examiner has provided absolutely no evidence that people drinking the tea suffer from PMS. In fact, there is no evidence on the record that compositions comprising isolated theanine were administered to treat women suffering from symptoms of PMS. Accordingly, the Examiner's rejection is improper and should be withdrawn.

Regarding the Examiner's rejection based on Fujii in view of Brown, Dinning and Woods, Applicants submit that this rejection is improper.

The primary reference of Fujii discloses a composition referred to as an anti-stress composition. The composition referred to in Fujii is based upon the administration of isoproterenol to lower an elevated heart rate. Fujii also discloses the lowering of elevated blood pressure and heart rate

by applying a stress load of calculation operation. Fujii provides absolutely no information that a lowering of blood pressure or heart rate is effective in the treatment of PMS. None of the secondary references cited by the Examiner provides this information either.

In the Office Action the Examiner states that theanine is known to be useful for anti-stress and cites Fujii as support for this assertion. Thus, the Examiner asserts that it is *prima facie* obvious to use theanine for suppressing or ameliorating PMS. However, Applicants submit that the Examiner's assertion is unsupported by evidence. Although stress is known to be related to PMS, the Examiner has provided absolutely no literature disclosing that PMS may be suppressed or ameliorated by suppressing stress. The causes of PMS are very complicated. Even now, it is not clear what causes PMS since various reports exist. Accordingly, Applicants submit that it is not known that any agents that suppress stress will also be effective in the treatment of PMS.

In summary, when each of the references are taken in combination, there is no suggestions or disclosure that the administration of the present composition would be useful in the

treatment of PMS. Accordingly, the Examiner's rejection is improper and should be withdrawn.

In view of the above, Applicants respectfully submit that the present claims define subject matter which is patentable over the prior art of record. Accordingly, the Examiner is respectfully requested to withdraw all rejections and allow the currently pending claims.

If the Examiner has any questions concerning this application, he is requested to contact Craig A. McRobbie, Registration No. 42,874 at the offices of Birch, Stewart, Kolasch & Birch, LLP.


Pursuant to the provisions of 37 C.F.R. §§ 1.17 and 1.136(a), the Applicants hereby petition for an extension of two (2) months to March 19, 2002 in which to file a reply to the Office Action. The required fee of \$400.00 is enclosed herewith.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees

required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17;
particularly, extension of time fees.

Respectfully submitted,

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Attachment: Version with Markings to Show Changes Made

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Claim 8 has been amended as follows:

8. (Twice Amended) A method for treating an individual in need of suppressing or ameliorating a symptom accompanying diminished homeostasis, comprising:

administering a composition comprising theanine to the individual in need thereof, wherein said composition is prepared by a method comprising a step of mixing isolated theanine with other ingredients.